

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 11, 16 and 17 will have been amended and are submitted for reconsideration by the Examiner. In addition, claims 18-27 will have been submitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

In the outstanding Official Action, the Examiner indicated that the oath or declaration is defective. The Examiner asserted that the oath does not have the inventor's signature and date. Applicant is quite puzzled by the Examiner's statement and respectfully traverses the same.

In this regard, Applicant notes that the Examiner raised the exact same objection to the declaration in the Official Action dated March 28, 2005, but did not again address this issue in any intervening Official Action.

Additionally, Applicant notes, as Applicant has set forth in the response filed in the present application on June 28, 2005, that an executed declaration was filed in the present application on September 10, 2001. Moreover, Applicant attached, to the above-noted response of June 28, 2005, a copy of the executed declaration together with a copy of the mailroom date-stamped receipt evidencing the filing of the same, in order to complete the record in the present application.

Accordingly, Applicant respectfully requests that in the next Official Action in the present application, the Examiner explicitly indicate that the executed declaration is present in the present application and was timely filed.

Turning to the merits of the action, the Examiner has rejected claims 11-17 under 35 U.S.C. § 103(a) as being unpatentable over MALIK (U.S. Patent No. 5,991,290). The Examiner has rejected claim 14 under 35 U.S.C. § 103(a) over MALIK in view of TASHIMA (U.S. Patent No. 6,567,178).

As noted above, Applicant has amended claims 11, 16 and 17 and resubmitted the same for consideration by the Examiner. Applicant respectfully traverses the above rejection based on the amended claims 11-17 and will discuss the outstanding rejection with respect to these claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 11-15 generally relate to a facsimile apparatus which transmits image data to a relay Internet facsimile apparatus via PSTN. The relay Internet facsimile apparatus transmits the image data to a plurality of receiving Internet facsimile apparatuses via the Internet. Each of the plurality of the receiving Internet facsimile apparatuses has a sub-address and an IP address. The facsimile apparatus has an input which inputs image data and a panel configured to input predetermined information identifying the relay Internet facsimile apparatus and sub-addresses of the plurality of receiving Internet facsimile apparatuses. The relay Internet facsimile apparatus has a memory that stores IP addresses of the plurality of receiving Internet facsimile apparatuses corresponding to the sub-addresses of the plurality of receiving Internet facsimile apparatuses.

The facsimile apparatus further comprises a controller which, when the predetermined information and the sub-addresses of the plurality of receiving Internet facsimile apparatuses are input by the panel, transmits, to the relay Internet facsimile apparatus via the PSTN, the input image data and the input sub-addresses of the plurality of receiving Internet facsimile apparatuses, based on the input predetermined information identifying the relay Internet facsimile apparatus. Further, the relay Internet facsimile apparatus determines whether the sub-addresses of the plurality of receiving Internet facsimile apparatuses are received from the facsimile apparatus. The relay Internet facsimile apparatus converts the transmitted image data into data for Internet transmission and relays the converted data to the plurality of the receiving Internet facsimile apparatuses via the Internet, based on the IP addresses of the plurality of receiving Internet facsimile apparatuses corresponding to the sub-addresses of the plurality of receiving Internet facsimile apparatuses stored in the memory, when it is determined that the sub-addresses of the plurality of receiving Internet facsimile apparatuses are received from the facsimile apparatus. On the other hand, the relay Internet facsimile apparatus prints out the transmitted image data, when it is determined that the sub-addresses of the plurality of receiving Internet facsimile apparatuses are not received from the facsimile apparatus. Claim 16 recites a related relay Internet facsimile apparatus. Claim 17 recites a related method.

In direct contrast, MALIK relates to a method and system for forming a digital facsimile message that includes a sub-address. In MALIK, destination server 30 converts the sub-address into a network address that will be used to route the message data 503 to destination terminal 50. The destination server 30 compares the extracted four digit sub-address to a set of IP addresses stored in a look-up table of a memory.

The destination server 30 creates the message header, and sends the facsimile data, which was earlier received by the destination server 30, to the destination terminal 50 (col. 7, line 66 through col. 8, line 24).

However, MALIK does not disclose a relay Internet facsimile apparatus that determines whether the sub-addresses of the plurality of receiving Internet facsimile apparatuses are received from the facsimile apparatus, the relay Internet facsimile apparatus printing out the transmitted image data when it is determined that the sub-addresses of the plurality of receiving Internet facsimile apparatuses are not received from the Internet facsimile apparatus. In this regard, MALIK does not contain any disclosure regarding determining whether the sub-addresses of the plurality of receiving Internet facsimile apparatuses are received from the facsimile apparatus, as shown in Fig.6. Thus, MALIK does not disclose a relay Internet facsimile apparatus that prints out the transmitted image data when it is determined that the sub-addresses of the plurality of receiving Internet facsimile apparatuses are not received from the Internet facsimile apparatus.

On the other hand, the pending claims recite a relay Internet facsimile apparatus that determines whether the sub-addresses of the plurality of receiving Internet facsimile apparatuses are received from the facsimile apparatus, the relay Internet facsimile apparatus printing out the transmitted image data when it is determined that the sub-addresses of the plurality of receiving Internet facsimile apparatuses are not received from the Internet facsimile apparatus. For this reason alone the pending claims are submitted to be allowable.

Further, in setting forth the rejection, the Examiner asserted that MALIK discloses transmitting the image data to a plurality of receiving Internet facsimile apparatuses (50-

53) via the Internet. Applicant respectfully submits that, while the Examiner's statement is technically correct, MALIK does not teach the feature recited in Applicant's claim. In fact, while MALIK discloses a plurality of network terminals (50-53), as can clearly be seen in Fig. 1, only terminal 50 is labeled as the "destination terminal". The message data is transmitted via the destination server 30 to the destination terminal 50 and only to the single destination terminal 50, based on the teachings of MALIK. As can be seen, e.g., in the summary of the invention, throughout the discussion of the MALIK invention, only a single destination terminal 50 is referred to. Destination terminals, in plural, are not referred to. Similarly, as is seen in Fig. 5, a single sub-address 501, 520 is shown. Plural sub-addresses are not shown.

In direct contrast to the showing of Fig. 5 of MALIK, the Examiner's attention is respectfully directed to Fig. 9 of Applicant's invention where a plurality of sub-address information is shown to be transmitted. Thus, contrary to the Examiner's assertion, MALIK is incapable of relaying the converted data to the plurality of receiving Internet facsimile apparatuses in a single transmission via the Internet, based on the IP addresses of the plurality of receiving Internet facsimile apparatuses corresponding to the sub-addresses of the plurality of receiving Internet facsimile apparatuses stored in the memory of the relay Internet facsimile apparatus" as recited in Applicant's claim 11.

In this regard, should the Examiner persist in maintaining her position that MALIK shows transmission of the image data to a plurality of receiving Internet facsimile apparatuses, the Examiner is respectfully requested to specifically identify the portions of the MALIK disclosure upon which she relies for this teaching.

Accordingly, for this yet additional and independent reason, it is respectfully submitted that the recitations of Applicant's claims are not taught, disclosed or rendered obvious by the MALIK disclosure.

Thus, the pending claims are clearly distinguished over MALIK.

Accordingly, it is respectfully submitted that the features recited in Applicant's claims 11-17 are not disclosed in MALIK cited by the Examiner. The pending claims are also submitted to be patentable over the Examiner's proposed reference since MALIK does not render obvious the combination of the above-noted features recited in Applicant's claims 11-17.

Regarding the rejection of claim 14 under 35 U.S.C. § 103 as unpatentable over MALIK in view of TASHIMA, Applicant submits that dependent claim 14 is dependent from allowable independent claim 11, which is allowable for at least the reasons discussed supra. Thus, the dependent claim 14 is also allowable for at least the reasons discussed supra. Further, the dependent claim sets forth a further combination of elements neither taught nor disclosed by the applied references.

In setting forth the rejection of claim 14, the Examiner asserts that since TASHIMA teaches that the fax ID can be transmitted as part of the TSI or NSS signals, one would have been motivated to transmit the sub-address of MALIK as NSS. It is respectfully submitted that there is no support for the Examiner's conclusion in the prior art.

TASHIMA merely discloses that the fax transmitting unit 4 transmits the FAX ID as the data TSI (NSS) to the destination FAX corresponding to a call originating FAX ID transmitting element. TASHIMA contains no teachings whatsoever regarding sub-

addresses or a relay Internet facsimile apparatus wherein the plurality of sub-addresses are transmitted to the relay Internet facsimile apparatus using an NSS signal.

Nor does TASHIMA contain any disclosure relating to transmitting a plurality of sub-addresses of the receiving Internet facsimile apparatus utilizing an NSS signal. The disclosure of TASHIMA is limited to transmitting FAX ID as data TSI (NSS) to the destination facsimile. There is no teaching of TASHIMA that is properly combinable with the disclosure of MALIK to render the recitations of claim 14 unpatentable as asserted by the Examiner.

In setting forth the rejection, the Examiner further asserts that the FAX ID comprises a sub-address. However, the Examiner has submitted no support for this assertion. And, in fact, Applicant submits that there is no support for this assertion. As set forth in TASHIMA column 5, lines 64-67, the FAX ID may be a telephone number of the call originating FAX or a name of a user of the call originating FAX or a name of section in which the call originating FAX is installed. However, there is no basis for the Examiner's assertion that the FAX ID is somehow analogous to a sub-address of a receiving Internet facsimile apparatus, as that term is utilized in the claims of the present application.

Therefore, it is respectfully submitted that the features recited in Applicant's claim 14 are not disclosed in TASHIMA by the Examiner. Claim 14 is also submitted to be patentable over the Examiner's proposed combination since neither MALIK, TASHIMA, nor the combination thereof render obvious the combination of the above-noted features recited in Applicant's claim 14.

Moreover, the Examiner has not set forth any proper motivation for the proposed combination. The Examiner has merely asserted that TASHIMA teaches either TSI or

NSS can be used for transmitting fax ID. However, the Examiner has not asserted any suggestion, teaching or motivation in the prior art for the proposed combination. Further, even if MALIK can be combined with TASHIMA as proposed by the Examiner, the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Neither of the relied upon references MALIK or TASHIMA suggests such a desirability.

Accordingly, for these additional reasons, Applicant respectfully submit that the Examiner has improperly combined MALIK and TASHIMA.

Claims 18-27 are submitted for consideration and are submitted to provide Applicant with the scope of protection to which he is entitled. These claims are submitted to be allowable over the prior art of record.

Accordingly, Applicant respectfully requests consideration and withdrawal of the outstanding rejections and requests an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for reconsideration by the Examiner and has submitted several new claims. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the claims with the disclosures of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Applicant has additionally traversed the Examiner's indication that the declaration in the present application is not executed and directed the Examiner to the relevant information regarding the filing of an executed declaration in the present application.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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